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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **SUGIYAMA, Kazuhiko, et al.**

Attention: Office of Petitions

Serial No.: **10/506,671**

Group Art Unit: **3679**

Filed: **April 7, 2005**

Examiner: **KEE, Fannie C.**

For: **PIPE JOINT**

P.T.O. Confirmation No.: 5308

PETITION FOR RETURN OF FORM PTO-1449 FILED ON JANUARY 4, 2006,

PURSUANT TO 37 C.F.R. §1.181

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Date: October 10, 2008

Dear Sir:

Applicants hereby petition to receive a copy of the Form PTO-1449 filed on January 4, 2006, marked to indicate that Item **AI**, the European Search Report dated October 20, 2005, has been considered.

* * * *

STATEMENT OF FACTS:

Applicants filed an Information Disclosure Statement at the U.S. Patent and Trademark Office (the Office) on January 4, 2006.

Applicants have enclosed the following documents: (1) a copy of the Information Disclosure Statement filed January 4, 2006; and (2) a copy of the postcard receipt stamped with the date January 4, 2006.

The Information Disclosure Statement filed January 4, 2006 included a Form PTO-1449 that listed at least the following document: Item AI: European Search Report dated October 20, 2005.

The Information Disclosure Statement filed on January 4, 2006 complied with all the requirements of 37 C.F.R. §1.97 and 37 C.F.R. §1.98. Thus, the Examiner has an obligation to consider all references listed therein.

The Examiner has an obligation to consider all references, including Item AI. However, the Examiner placed a line through Item AI, even though a legible copy of the corresponding document was enclosed, and even though the corresponding document was in the English language.

That is, the Examiner placed a line through the European Search Report dated October 20, 2005 (Item **AI**), even though a legible copy of the search report was enclosed, and even though the search report was in the English language.

The Examiner, Ms. Fannie Kee, was reached by telephone on October 3, 2008. During the telephone interview on October 3, 2008, Examiner Kee did not resolve the Applicants' concerns regarding the lining-through of Item **AI**. Examiner Kee suggested that the lining-through of Item **AI** was proper. Examiner Kee suggested that search reports should not be listed on the Form PTO-1449, because search reports do not belong there.

Examiner Kee refused to provide Applicants with a copy of the Form PTO-1449 which accompanied the Information Disclosure Statement filed on January 4, 2006, marked to indicate that Item **AI** has been considered by the Office. During the interview, no agreement was reached regarding the lining-through of Item **AI**.

During the interview, Examiner Kee stated that she placed a line through Items **AF**, **AG**, and **AH** because those three items were listed on a different Form PTO-1449. Document numbers DE63526C, DE9011772U1, and GB745847A were listed on the Form PTO-1449 filed with the Information Disclosure Statement on February 21, 2006. The Examiner confirmed that Document numbers DE63526C, DE9011772U1, and GB745847A were considered in their entirety, as

demonstrated by her initials next to the corresponding items on the Form PTO-1449 filed with the Information Disclosure Statement on February 21, 2006.

* * * *

REMARKS:

Applicants respectfully submit that the lining-through of Item AI was improper, for the following reasons.

Applicants respectfully submit that it was an error of the Office. Applicants respectfully request that the error of the Office be corrected by the Office now.

During the telephone interview on October 3, 2008, Examiner Kee took the position that search reports should not be listed on the Form PTO-1449, because search reports do not belong there.

The Manual of Patent Examining Procedure (MPEP) provides guidelines that do not support the Examiner's position. For example, MPEP §609 states "There is no requirement that the information must be prior art references in order to be considered by the examiner."

The first Office action on the merits was mailed March 8, 2007. "An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods: ... (3) Before the mailing of a first Office action on the merits." 37 C.F.R. §1.97(b)(3).

Therefore, the Information Disclosure Statement filed on January 4, 2006 was filed before the first Office Action on the merits. Accordingly, the Information Disclosure Statement filed January 4, 2006 should have been considered by the Office.

37 C.F.R. §1.98(a) states "Any information disclosure statement filed under 37 C.F.R. 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3)."

In compliance with 37 C.F.R. §1.98(a)(1), the Information Disclosure Statement filed on January 4, 2006 listed documents for consideration by the Office, including at least: Item AI: European Search Report dated October 20, 2005.

In compliance with 37 C.F.R. §1.98(a)(2), a legible copy of Item AI was included.

In compliance with 37 C.F.R. §1.98(a)(3), Item AI is in the English language, and thus no translation or concise explanation of the relevance is needed. 37 C.F.R. §1.98(a)(3)(i) states "A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separated from applicant's specification or incorporated therein" (emphasis added).

MPEP §609 states "Once the minimum requirements of 37 C.F.R. §1.97 and 37 C.F.R. §1.98 are met, the examiner has an obligation to consider the information."

MPEP §609 states "There is no requirement that the information must be prior art references in order to be considered by the examiner."

MPEP §609 states "The initials of the examiner placed adjacent to the citations on the PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner."

Applicants respectfully submit that it was improper for the Examiner to place a line through Item AI. Applicants respectfully submit that it was an error of the Office. Applicants respectfully request that this error of the Office be corrected now.

It is therefore respectfully requested that the Office return the copy of the Form PTO-1449 which accompanies the Information Disclosure Statement filed January 4, 2006, marked to indicate that Item AI listed therein has been considered by the Office.

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RELIEF REQUESTED:

Applicants therefore respectfully request the following relief.

1. Applicants request that the Office return a copy of the Form PTO-1449 which accompanied the Information Disclosure Statement filed January 4, 2006, marked to indicate that Item AI listed therein has been considered by the Office.
2. Applicants request all other relief as justice may require.

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It is believed that no fee is due with respect to this petition. However, if any fees are due now or in the future in connection with this petition, please charge our Deposit Account No. 01-2340. If any fees are due now or in the future in connection with this application, please charge our Deposit Account No. 01-2340.

Respectfully submitted,
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PATENT & TRADEMARK OFFICE

Enclosures: Copy of Information Disclosure Statement filed January 4, 2006
Copy of date stamped postcard receipt